The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte DAVID B. LYTLE

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Appeal No. 2004-0778
Application No. 10/172,933

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ON BRIEF

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Before GARRIS, KRATZ, and JEFFREY T. SMITH, Administrative Patent Judges.

GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal which involves claims 1-10.

The subject matter on appeal relates to a method of making a magnetically attractive coating composition consisting of the steps of providing a paint and mixing iron particles with the paint. Further details of this appealed subject matter are set

forth in representative independent claim 1 which reads as follows:

1. A method of making a magnetically attractive coating composition consisting of the steps of:

providing a paint; and

mixing iron particles with the paint to produce a mixture, wherein the concentration of the iron particles in the mixture is about 70 to about 85 wt.%.

The reference set forth below is relied upon by the examiner as evidence of obviousness:

Deetz 5,843,329 Dec. 1, 1998

All of the appealed claims stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Deetz.[1]

We refer to the brief and reply brief and to the answer for a complete exposition of the contrary viewpoints expressed by the appellant and by the examiner concerning the above noted rejection.

OPINION

For the reasons set forth in the answer and below, we will sustain this rejection.

[1] As indicated on page 4 of the brief, the claims on appeal will stand or fall together. Accordingly, we will focus on independent claim 1, which is the broadest claim before us, as representing the rejected claims. See 37 CFR § 1.192(c)(7)(2003).

The only argued distinction of the appealed claims over Deetz relates to mixing iron particles only with the paint as required by the claims before us by virtue of the closed independent claim language "consisting of the steps of." According to the appellant, Deetz's corresponding mixing step involves a wetting agent or emulsifier to assist in dispersing the iron particles in the paint. Thus, it is the appellant's basic position that the Deetz patent contains no teaching or suggestion of mixing iron particles only with the paint.

On the other hand, it is the examiner's fundamental position that Deetz teaches or at least would have suggested mixing iron particles only in the paint via the disclosure at lines 59-63 in column 4 wherein patentee teaches adding such particles directly to paint followed by a teaching of preferred embodiments wherein a wetting agent or emulsifier is used to assist in dispersing the particles. The appellant responds to the examiner's position by arguing that this column 4 disclosure is inconsistent with the reference as a whole which, in the appellant's view, "actually teaches away from using only iron particles" (reply brief, pages 3-4). We cannot agree with the appellant.

Patentee's column 4 teaching that iron particles may be added directly to paint is explicit and unambiguous. While this

teaching may relate to a non-preferred embodiment, it is well established that an applied reference may be relied upon to establish obviousness under 35 U.S.C. § 103 not only for the preferred embodiments disclosed therein but for all that it would have reasonably suggested to one having ordinary skill in the art. Merck & Co. v. Biocraft Labs., 874 F.2d 804, 807, 10 USPQ2d 1843, 1846 (Fed. Cir. 1989). In view of this legal principle, we are convinced that Deetz teaches or at least would have suggested mixing iron particles only with paint as required by the appealed claims. The appellant's opposing arguments including the aforementioned "teaching away" argument lack persuasive merit because they are contrary to the explicit and unambiguous column 4 teaching of Deetz.

In light of the foregoing, it is our determination that the reference evidence adduced by the examiner establishes a prima facie case of unpatentability which the appellant has failed to rebut with argument and/or evidence of patentability. We shall sustain, therefore, the examiner's section 103 rejection of all appealed claims as being unpatentable over Deetz. See In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

The decision of the examiner is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

Bradley R. Garris Administrative Patent Judge	)	
Peter F. Kratz Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
Jeffrey T. Smith Administrative Patent Judge	)	

BRG:tdl

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